

### **III. REMARKS**

In the Office Action, claims 1-5, 7-12, 15 and 17-20 were rejected under 35 U.S.C. 102(b) as being anticipated by Byrne (US 5,737,703) for reasons set forth in the Office Action.

With respect to the rejections under 35 U.S.C. 102, claim 1 is amended and the following argument is presented to distinguish the claimed subject matter from the teachings of the cited art, thereby to overcome the rejections and to show the presence of allowable subject matter in the claims.

The examiner's comments (Office Action, page 2) on the teaching of Byrne show that there is a direct request for a specific type of radio access network. The examiner states that an intersystem handover from the radio access network of the first type to the radio access network of the second type should be performed based on a requested content of a control signal. This is consistent with the teaching of Byrne (col. 2 at lines 25-30) that describes an automatic entry of a user defined preferred mode for answering an incoming call if the system corresponding to that mode is available.

To distinguish over this "direct request", Claim 1 is amended by inclusion of the feature "wherein said transmission determines a type of radio access network based on one of a requested content, a requested access point name, a requested uniform resource location and a requested internet protocol address". Support for the amendment is provided in the present specification, by way of example, in the paragraphs [0023], [0030], [0067], [0075] of the published application. In view of the foregoing argument, this amendment is believed to overcome the rejections of claim 1 and its dependent claims so as to secure allowable subject matter.

New claim 37, corresponding to the amended claim 1, is directed to a mobile terminal, but includes subject matter set forth in both claims 22 and 1. In view of the inclusion of

much of the subject matter of claim 1, it is believed proper to examine claim 37 with claim 1, and that no further restriction should be required.

New claim 38, corresponding to the amended claim 1, is directed to a network element, but includes subject matter set forth in both claims 32 and 1. In view of the inclusion of much of the subject matter of claim 1, it is believed proper to examine claim 38 with claim 1, and that no further restriction should be required.

The following additional argument is made with respect to the patentability of claim 1.

The present specification (bottom of page 1) makes reference to mobile terminals that are referred to as multi-mode terminals, wherein one example for a multi-mode terminal is a 2G/3G dual-mode terminal. The specification (page 8, starting at line 12) describes equipment for use in the practice of the claimed subject matter as a dual mode terminal such as a 3G/2G mobile terminal, wherein the first radio access network is a 3G radio access network and the second radio access network is a 2G radio access network.

Byrne (col. 1 at lines 21-41) states that known radio telephones capable of operating in more than one system typically consist of little more than two separate phones combined in a single housing. Byrne refers to a multi-mode radio telephone which is a combination of a cellular telephone system and a cordless telephone system.

The language "multi-mode radio telephone" of Byrne is similar to the language "multi-mode terminal" and "dual mode terminal" used by the present specification.

The examiner in Point 2 of the Action makes reference to terminology appearing in present claim 1, namely, the radio access networks of the first type and of the second type. The examiner states that the terminology, radio access network of the first type, reads on the cellular system of Byrne, and that the terminology, radio access network of the second type, reads on the cordless system of Byrne.

It is well known that the cordless telephone apparatus employed in numerous homes has a mobile part which a person may carry about a house, and a fixed part (akin to a base station) that converts the telephone signals, radiated from the mobile part to the fixed part, to signals suitable for a land-line system, and then transmits the signals away from the house via a land-line telephone system. Such signals may later be transferred from the land-line system to a radio or cellular communication system. With respect to the cited teachings of Byrne, it is clear that his multi-mode telephone has one mode in which his combination terminal can communicate directly to a radio or cellular communication system, and a second mode in which his combination terminal can communicate indirectly via a land-line phone system to a radio or cellular communication system. In fact, Byrne (col. 1 at lines 38-41) specifically states that connection of the cordless telephone is made to the Public Switched Telephone Network (PSTN).

It is clear from the above-cited passages of the present specification, on pages 1 and 8, that the teachings of the specification deal with a mobile terminal that communicates via radio signals employing a plurality of modes directly with a radio or cellular communication system. From the examples given in the cited passages, as well as from the presentation of Fig. 1, it is clear that the teachings of the specification are not directed to one mode of communication via a land line, and another mode of communication via a radiated signal in order to access a radio communication system.

The foregoing point is emphasized by the teaching in the specification (middle of page 2), which states: "The most important reason for an intersystem handover is differences of coverage and quality in the communication system. In some situations, the coverage of a first radio access system to which a moving mobile terminal is currently connected may end. Moreover, the radio connection quality provided by this first radio access system may degrade below a given threshold value. If at the same time, another radio access system still provides coverage and/or a better radio connection quality, an

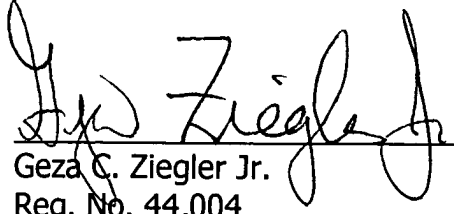
intersystem handover can guarantee a continued and satisfactory supply of the mobile terminal. The first radio access system is typically a WCDMA system and the second radio access system a GSM/GPRS system." It is noted that both of the first and the second access systems are referred to as "radio access systems", a description that is not employed for a land-line system used for home cordless phones. Furthermore, this terminology appears also in the middle of page 5 of the specification.

With respect to the language of claim 1, it is observed that the wording "radio access network" appears in the claim. This is believed to distinguish over the PSTN of Byrne. In order to clarify the distinction between the subject matter of claim 1 and the teachings of Byrne still further, a new claim 39 is presented which includes the subject matter of claim 1, and includes also the term "direct" in describing the radio access networks. "Direct" rules out the use of a PSTN to gain access to a radio or cellular communication system. In view of the foregoing argument, claim 39 is believed to be free of the rejections of claim 1, and to have allowable subject matter.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

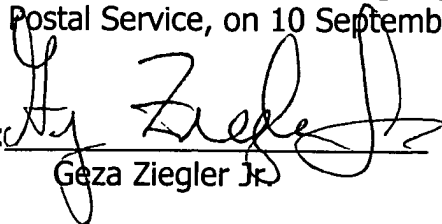
  
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10 September 2009  
Date

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#### **CERTIFICATE OF MAILING**

This is to certify that the foregoing Amendment was mailed, via First Class mail with the US Postal Service, on 10 September 2009.

By:   
Geza Ziegler Jr.